

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed January 25, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Allowable Subject Matter

Applicant appreciates the Examiner's indication that claim 22 is allowable over the prior art of record.

In that it is believed that every rejection has been overcome, it is respectfully submitted that each of the claims that remains in the case is presently in condition for allowance.

II. Double Patenting Rejections - Obviousness-type Double Patenting

Obviousness-type double patenting is a judicially created doctrine that prevents separate patents from issuing that have claims which are so similar as to render the claims of one patent obvious in view of the other. *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 16 U.S.P.Q.2d 1436 (Fed. Cir. 1990). Accordingly, for an obviousness-type double patenting rejection to be proper, the alleged unpatentable claims must be established to be obvious in view of the claims asserted in the applied patent or patent application. Therefore, just as with rejection under section 103, the U.S. Patent and Trademark Office ("USPTO") has the burden to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of the ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837

F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In the present case, the '863 patent fails to teach or suggest each of the pending claim limitations.

A. Claims 1-19

Claims 1-19 have been rejected under the doctrine of obviousness-type double patenting as being unpatentable in view of claim 1 of U.S. Patent No. 6,972,863 ("the '863 patent"). Applicant respectfully traverses.

Applicant's claim 1 provides as follows (emphasis added):

1. A printing method, comprising the steps of:
receiving print stream data at a printer;
detecting an external network address in the received print stream data;
obtaining at least one parameter of a document at the external network address;
determining if the at least one parameter meets a predetermined first criteria;
if the at least one parameter meets the first criteria, then retrieving the document from the external network address;
merging the document into the print stream data to form a modified document; and
printing the modified document.

Claim 1 of the '863 patent at least fails to teach or suggest "obtaining at least one parameter of a document at the external network address" and "determining if the at least one parameter meets a predetermined first criteria" as required by pending claim 1. This

fact is apparent when claim 1 of the '863 patent is reviewed. That claim provides as follows:

1. A printing method, comprising the steps of:
receiving print stream data at a printer;
detecting a barcode in the received print stream data;
translating the barcode to an external network address;
sending on the Internet or other external network an access request
for a document to the external network address;
retrieving the document from the external network address;
selecting at least one portion of the document retrieved from the
external network address;
merging the at least one selection portion of the retrieved document
from the network address into a second document, at least part of which is
defined by the print stream data, to form a modified document; and
printing the modified document.

U.S. Patent No. 6,972,863, claim 1.

Nowhere in the above claim is “obtaining” a “parameter of a document” at the external network address or “determining” if the parameter “meets a predetermined first criteria” described.

In the Office Action, it is argued that “[t]he retrieving and selecting step is equivalent to the present application’s obtaining step.” Applicant disagrees. As is apparent from above, the “retrieving step” of claim 1 of the '863 patent retrieving “the document.” Claim 1 of the '863 patent does not mention that that retrieving also includes retrieving any “parameter” of the document along with the document.

Applicant further notes that the Office Action ignores the explicit limitation “determining if the at least one parameter meets a predetermined first criteria” contained in pending claim 1. Regardless, it is clear that claim 1 of the ‘863 patent does not recite anything that is “equivalent” to that limitation.

In view of the above, claims 1-19 and its dependents are not obvious in view of claim 1 of the ‘863 patent.

B. Claim 20

Claim 20 has been rejected under the doctrine of obviousness-type double patenting as being unpatentable in view of claim 24 of the ‘863 patent. Applicant respectfully traverses.

Regarding pending claim 20, Applicant asserts that claim 24 of the ‘863 patent does not teach or suggest every limitation of claim 20. Specifically, claim 24 does not teach or suggest “computer code for obtaining at least one parameter of a document at the external network address” or “computer code for determining if the at least one parameter meets a predetermined first criteria”. Like claim 1 of the ‘863 patent, claim 24 of the ‘863 patent is silent as to “obtaining” a parameter or “determining” if that parameter meets “a predetermined first criteria”.

C. Claim 21

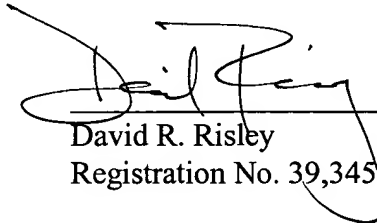
Claim 21 has been rejected under the doctrine of obviousness-type double patenting as being unpatentable in view of claim 23 of the ‘863 patent. Applicant respectfully traverses.

Regarding pending claim 21, Applicant asserts that claim 23 of the '863 patent does not teach or suggest every limitation of claim 21. Specifically, claim 23 does not teach or suggest "a component for obtaining at least one parameter of a document at the external network address" or "a component for determining if the at least one parameter meets a predetermined first criteria". Like claim 1 of the '863 patent, claim 23 of the '863 patent is silent as to "obtaining" a parameter or "determining" if that parameter meets "a predetermined first criteria".

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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4-13-06
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Signature